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EXAMINER

VO, HAI

ART UNIT PAPER NUMBER

1771

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,901

Applicant(s)

NISHIZAWA ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0113.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-11 in the reply filed on 08/19/2004 is acknowledged. The traversal is on the ground(s) that there would be no undue burden if all of the claims were examined together since the search of the elected claims would include the classes, subclasses appropriate for searching non-elected claims. This is not found persuasive because the search of elected claims (428/317.9) does not require a search in the same areas as a search for non-elected claims (427/ 457).

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-8, 10 and 11 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 2000 22601. US 6,620,473 to Nishizawa et al is relied on as an equivalent form of 2000 22601. Nishizawa teaches an in-mold forming label comprising a stretched film of void containing thermoplastic resin having a void content of 5 to 60% (column 5, lines 10-11). The biaxially stretched film contains a polyolefin resin, 5 % to 30% by weight of an inorganic powder (column 4, lines 45-50). The biaxially stretched film contains titanium oxide with the particle size

and the content within the ranges disclosed in the specification. It appears that the opacity of the stretched film is determined by the amount of titanium oxide. Therefore, it is not seen that the stretched film would have the opacity outside the claimed range when the same amount of titanium oxide is used in the film. Like material has like property. This is in line with *Ex parte Tummers et al.* 137 USPQ 444 which holds that if the chemical composition of the claimed article of manufacture recited in the claims is the same as the identical structure of the prior art, it is immaterial that the applicant recognized different advantages flowing therefrom than did the prior art. The same token is applied to the attractive force of the film. The stretched film is made of the material with a composition similar to the composition of the stretched film of the present invention. The stretched film comprises a polyolefin resin, an inorganic powder in the amount within the claimed range. The stretched film is a biaxially oriented multilayer film and has a void content within the claimed range. Therefore, it is the examiner's position that the attractive force between sheets of the film would be inherently present. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Accordingly, Nishizawa anticipates the claimed subject matter.

4. Claims 1, and 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin (US 5,552,001). Lin teaches a synthetic paper comprising a stretched film of

void- containing thermoplastic resin having a whiteness or opacity of 94% (table 1). The biaxially stretched film contains a polypropylene resin, 15 to 22% by weight of an inorganic powder (column 3, lines 60-65), and an antistatic agent (column 4, lines 1-5). Lin does not specifically disclose the porosity and attractive force between the layers. The stretched film is made of the material with a composition similar to the composition of the stretched film of the present invention. The stretched film comprises a polyolefin resin, an antistatic agent and an inorganic powder in the amount within the claimed range. The stretched film is a biaxially oriented multilayer film and has a whiteness meeting the specific range required by the claims. Lin discloses that the voids are generated around the inorganic powders when the film is subjected to stretching. This is exactly what Applicants do to create the voids within the film. Therefore, it is the examiner's position that the porosity and the attractive force between the layers of the film would be inherently present. Like material has like property. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Accordingly, Lin anticipates the claimed subject matter.

5. Claims 1, 3-8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 947 544. EP'544 teaches an in-mold forming label comprising a stretched film of void containing thermoplastic resin having a void content of 33

(table 1 (continued)). The biaxially stretched film contains a polyolefin resin, 0.5 % to 60% by weight of an inorganic powder [0043]. The biaxially stretched film contains titanium oxide with the particle size and the content within the ranges disclosed in the specification. It appears that the opacity of the stretched film is determined by the amount of titanium oxide. Therefore, it is not seen that the stretched film would have the opacity outside the claimed range when the same amount of titanium oxide is used in the film. Like material has like property. This is in line with *Ex parte Tummers et al.* 137 USPQ 444 which holds that if the chemical composition of the claimed article of manufacture recited in the claims is the same as the identical structure of the prior art, it is immaterial that the applicant recognized different advantages flowing therefrom than did the prior art. The same token is applied to the attractive force of the film. The stretched film is made of the material with a composition similar to the composition of the stretched film of the present invention. The stretched film comprises a polyolefin resin, an inorganic powder in the amount within the claimed range. The stretched film is a biaxially oriented multilayer film and has a void content within the claimed range. Therefore, it is the examiner's position that the attractive force between sheets of the film would be inherently present. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Accordingly, EP'544 anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 2000 22601. US 6,620,473 to Nishizawa et al is relied on as an equivalent form of 2000 22601. Nishizawa teaches the stretched film is subjected to corona discharge to improve the printability of the surface of the stretched film. However, Nishizawa does not teach the stretched film having a charge potential from -10 to 10 kV on the surface after discharging of the film. Therefore, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the stretched film having a charge potential from -10 to 10 kV on the surface motivated by the desire to improve the printability of the surface of the stretched film. This is in line with *In re Aller*, 105 USPQ 233 which holds that discovering the optimum or workable ranges involves only routine skill in the art.
8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 2000 22601 as applied to claim 1 above, further in view of Burns et al (US 6,534,189). Nishizawa does not specifically teach the core layer of the finely porous stretched film containing an antistatic agent. Burns, however, teaches a biaxially oriented

multilayer film suitable for use in labeling comprising at least one skin layer and a voided core layer that contains an antistatic agent for elimination the static effect resulted from processing friction. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the antistatic agent in the core layer of the finely porous stretched film motivated by desire to eliminate the static effect resulted from processing friction.

9. Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lin (US 5,552,011). Lin does not specifically disclose the synthetic paper suitable as a label. It is noted that mere recitation of "an in-mold-forming label" impacts no definite structure to the claimed stretched film and is therefore found inadequate to convey structure in any patentable sense. Further, the preamble "an in-mold-forming label" has not given patentable weight because the preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. **Kropa v. Robie**, 88 USPQ 478 (CCPA 1951). Accordingly, it is the examiner's position that Lin anticipates or strongly suggests the claimed subject matter.
10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin (US 5,552,011). Lin teaches the synthetic paper is subjected to corona discharge to improve the printability of the surface of the stretched film (column 5, lines 35-40). However, Lin does not teach the synthetic paper having a charge potential

from -10 to 10 kV on the surface after discharging of the paper. Therefore, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the stretched film having a charge potential from -10 to 10 kV on the surface motivated by the desire to improve the printability of the surface of the synthetic paper. This is in line with *In re Aller*, 105 USPQ 233 which holds that discovering the optimum or workable ranges involves only routine skill in the art.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 947 544. EP'544 teaches the stretched film is subjected to corona discharge to improve the printability of the surface of the stretched film. However, EP'544 does not teach the stretched film having a charge potential from -10 to 10 kV on the surface after discharging of the film. Therefore, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the stretched film having a charge potential from -10 to 10 kV on the surface motivated by the desire to improve the printability of the surface of the stretched film. This is in line with *In re Aller*, 105 USPQ 233 which holds that discovering the optimum or workable ranges involves only routine skill in the art.

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 947 544 as applied to claim 1 above, further in view of Burns et al (US 6,534,189). EP'544 does not specifically teach the core layer of the finely porous stretched film containing an antistatic agent. Burns, however, teaches a biaxially oriented

multilayer film suitable for use in labeling comprising at least one skin layer and a voided core layer that contains an antistatic agent for elimination the static effect resulted from processing friction. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the antistatic agent in the core layer of the finely porous stretched film motivated by desire to eliminate the static effect resulted from processing friction.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

Hai Vo

Tech Center 17th